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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LYNETTE DAMIR and JEFF DAMIR

Appeal 2009-014234
Application 10/751,070
Technology Center 3700

Before WILLIAM F. PATE, III, JOHN C. KERINS and STEVEN D.A.
McCARTHY, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lynette Damir and Jeff Damir (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 39, 41 and 44-51, all of the claims currently pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a blanket for swaddling an infant having a sheet of textile material attached to the blanket, the sheet containing instructional information. Independent claim 39, reproduced below, is illustrative of the claimed subject matter:

39. A blanket for swaddling an infant, the blanket comprising:

a generally planar sheet of textile material having a first-fold illustration, second-fold illustration, and third-fold illustration attached to the blanket and being integrated into a sequence;

the first-fold illustration locating and instructing the folding of a first fold line and folding of the blanket to cover the infant;

the second-fold illustration locating and instructing the folding of a second fold line and folding of the blanket to cover the infant; and

the third-fold illustration locating and instructing the folding of a third fold line and folding of the blanket to cover the infant.

THE REJECTIONS

The Examiner has rejected claims 39, 41 and 44-51 under 35 U.S.C. § 103(a) as being unpatentable over Isola (US 3,613,133, issued October 19, 1971) in view of common knowledge concerning the technique for swaddling an infant in a blanket.

ISSUE

Does the provision of instructional illustrations on a sheet of textile material attached to a blanket confer patentability on the claimed blanket?

ANALYSIS

Appellants argue claims 39, 41 and 44-51 as a group. We will take independent claim 39 as being representative of the group, with claims 41 and 44-51 standing or falling with claim 39.

The Examiner concluded that the subject matter of claim 39 would have been obvious, in view of the teachings of Isola in regard to attaching illustrative matter to a blanket (Isola, col. 1, ll. 32-33), and the known technique for swaddling an infant in a blanket. (Ans. 6). The Examiner maintains that the difference between Isola and the claimed invention is in the descriptive material attached to the blanket, and, citing to *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), maintains that the descriptive material is nonfunctional and thus not given patentable weight. (Ans. 11).

Appellants contend that the *Ngai* case is distinguishable, in that, “[u]nlike *Ngai*, the instructions are attached and that attachment is a distinct element.” (Appeal Br. 9). Appellants elsewhere aver that “it is the attachment of the graphic instructions to the blanket that is the patentable limitation”. (Appeal Br. 11). Appellants further attempt to liken the claimed

blanket to the band or ring at issue in *In re Gulack*¹, urging that “the instant claims are directed to a device where the printed matter has a functional relationship to the substrate”. (Appeal Br. 8). Appellants explain that “the blanket and the set of instructions are functionally linked”, in that “(1) the blanket supports the illustrations; and (2) the illustrations aid in the appropriate use of the blanket during times when . . . ready reference to the instructions might be necessary”. (Appeal Br. 9).

The attachment of instructions to the known blanket does not distinguish the present situation over the holding in *Ngai*, in which the Court expressly stated that inventor Ngai was, “not . . . entitled to patent a known product by simply *attaching* a set of instructions to that product.” *Ngai*, 367 F.3d at 1339. Appellants’ contentions directed to the printed matter in the form of graphic instructions having a functional relationship to the blanket are equally unavailing. The Federal Circuit, in *AstraZeneca LP v. Apotex Inc.*², noted that the *Ngai* decision “foreclosed the argument that simply adding new instructions to a known product creates the functional relationship necessary to distinguish the product from the prior art.” *AstraZeneca LP*, 633 F.3d at 1065.

At issue in the *AstraZeneca* case was a claim to a kit that included a known drug composition and a label containing instructions for frequency of administration of the drug. *Id.* at 1063. The opinion explained, in terms of the type of functional relationship necessary to potentially impart patentable weight to the printed matter, that the instructions there in no way functioned with the drug to create a new, unobvious product, and that removing the

¹ 703 F.2d 1381 (Fed. Cir. 1983)

² 633 F.3d 1042 (Fed. Cir. 2010)

instructions from the claimed kit did not change the ability of the drug to treat respiratory diseases. *Id.* at 1065. Similarly, the graphic instructions claimed here in no way function with the blanket to create a new, unobvious blanket, and removing the instructions from the blanket would not change the ability of the blanket to be swaddled around an infant.

Further, Appellants have reminded us (Appeal Br. 9-10), that the *Gulack* and *Lowry*³ decisions caution against a liberal use of printed matter rejections under § 103. *Gulack*, 703 F.2d at 1385, n. 8; *Lowry*, 32 F.3d at 1583. Those decisions highlight, as do Appellants, that the Patent and Trademark Office must consider all claim limitations when determining patentability of an invention over the prior art, and may not disregard claim limitations comprised of printed matter. The rejection affirmed herein does not disregard the limitations directed to the attachment of graphic instructions to the blanket. Rather, we have determined, as discussed above, that the facts before us in the present appeal are very close in nature to those in *Ngai* and in *AstraZeneca*, whereas, in *Gulack*, an actual functional relationship between the printed matter and the substrate was found to be present, and, in *Lowry*, the court found that the data structures at issue were improperly regarded as printed matter at the outset. *Id.* As such, in accordance with the guidance provided by the *Ngai* and *AstraZeneca* decisions, we conclude that the attachment of graphic instructions to a blanket, which instructions are directed to folding the blanket, does not create the functional interrelationship necessary to create a new, unobvious blanket.

³ *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994)

Inasmuch as we have found that the Examiner met the burden of showing that the subject matter of Appellants' claim 39 is prima facie obvious, and because Appellants have furnished evidence in rebuttal of obviousness, we now turn to consider this evidence. When such evidence is presented, it is our duty to consider all evidence anew. *See, e.g., In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990). We are also mindful that objective evidence of non-obviousness in any given case may be entitled to more or less weight depending on its nature and its relationship with the merits of the invention. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon by the Examiner and the objective evidence of non-obviousness provided by the Appellants.

We agree, in large part, with the Examiner's treatment and weighing of the evidence presented in the Declarations of Lynette Damir, RN, and Pamela Jordan, PhD, RN. (hereafter, the "Damir Declaration" and the "Jordan Declaration", respectively). The Damir Declaration purports to present evidence that the claimed invention has achieved commercial success, fulfills long-felt but unsolved needs, and has received praise. The Jordan Declaration purports to provide expert testimony as to the claimed blanket being very helpful to new parents, and that the claimed blanket provides a long-needed solution to a problem encountered by new parents.

The evidence of commercial success presented in the Damir Declaration is to the effect that 300,000 blankets have been sold, that sales growth over 2000% was experienced over the course of three years, that

barriers to entry exist in the crowded baby blanket market or product category, and that retail sales continue to increase. (Damir Decl., pp. 7-8).

Even if we assume that the reported sales are a direct result of the unique characteristics of the claimed blanket, evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. *Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1026-7 (Fed. Cir. 1985)(finding that sales of 5 million units represent a minimal indicator of commercial success because “[W]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market”); *see also In re Baxter Travenol Lab.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (information directed solely to numbers of units sold is insufficient to establish commercial success). Evidence of the percentage growth in sales, as well as continued increase in retail sales, are equally unpersuasive without being accompanied by evidence that the growth has resulted in Appellants having captured a substantial share of a definable market. The statement directed to the existence of barriers to entry into the baby blanket market is unsupported by underlying facts evidencing this to be the case.

The statements directed to long-felt but unsolved needs address only Ms. Damir’s experiences, and not those of the baby blanket industry. No evidence is presented that others in the field had unsuccessfully attempted to meet the alleged long-felt need. Evidence of long felt need must show that the problem solved by Applicant’s invention was known but not solved prior to the invention. *See Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1325 (Fed. Cir. 1999). To show failure of others, the evidence must establish that others skilled in the art tried and failed to find a solution for the problem

solved by the Applicant. *Stratoflex*, 713 F.2d at 1540. One must also show that the others who failed had knowledge of the critical prior art. *In re Caveney*, 386 F.2d 917, 923 (CCPA 1967). The evidence of record is lacking in these respects.

Appellants' evidence of copying has little to no probative value. The alleged copying by The Gap admittedly "did not include an instructional tag sewn to the edge of the blanket." (Damir Decl., p. 9). The alleged copying by Babystyle admittedly "included swaddling instructions in the packaging", and Babystyle admittedly "did not attempt to copy a sewn instruction tag and did not sew instructions to the edge of the blanket." (Damir Decl., p. 10). The second incident of alleged copying by The Gap admittedly evidences, "that they have not sold the blanket with the [instruction] label". (Damir Decl., pp. 10-11). The first two instances do not evidence copying of the claimed invention, and the last does not evidence an instance of copying.

The evidence that the product has received praise is limited to apparent praise received from Dr. Pamela Jordan, the Overlake Regional Medical Center, and to an unknown number of unspecified "individuals" who had recently had babies. (Damir Decl., pp. 11-13). Appellants cite to *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092 (Fed. Cir. 1987) as authority that praise of the invention is properly considered to be evidence of nonobviousness. (Appeal Br. 11). The decision in *Allen Archery*, however, identified praise in the industry, and specifically praise from a competitor, as tending to indicate nonobviousness of a claimed invention. *Id.* Since the evidence related to praise of the invention is of a very limited nature, and seemingly does not emanate from the baby blanket

industry, we do not attach strong probative weight to the evidence.

The Jordan Declaration is of little value. That the claimed blanket is very helpful to new parents is not persuasive evidence of nonobviousness. As is the case with the Damir Declaration, the statements concerning a long-needed solution are unsupported by underlying evidence of prior unsuccessful attempts by persons of ordinary skill in the art, having the best prior art before them, to fulfill the need.

Because Appellants' evidence of secondary considerations fails to establish commercial success, long-felt need, or any other recognized consideration, we conclude that the evidence relied upon by the Examiner outweighs Appellants' evidence of secondary considerations, and thus we will sustain the Examiner's legal conclusion of obviousness

CONCLUSION

The provision of instructional illustrations on a sheet of textile material attached to a blanket does not confer patentability on the blanket set forth in claims 39, 41 and 44-51.

DECISION

The decision of the Examiner to reject claims 39, 41 and 44-51 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-014234
Application 10/751,070

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